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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,461	05/18/2001	Shinichi Yoshinari	Q64426	3963

7590 11/25/2003  
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC  
2100 Pennsylvania Avenue, N.W. Suite 800  
Washington, DC 20037-3213

EXAMINER
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HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 11/25/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

CL 013

## Office Action Summary

Application No.

09/859,461

Applicant(s)

Yoshinari

Examiner

Bruce Hess

Group Art Unit

1774

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 8-7-03 (Amdt) and 9-13-03 (IDS)

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1, 2, 4, 6 and 17-29 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 2, 4, 6, 17-21 and 23-29 is/are rejected.

☒ Claim(s) 22 is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 12

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other \_\_\_\_\_

Office Action Summary

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1. Claims 1, 4, 18, 19, 21, 23, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsieh in view of applicants' statement of the prior art for the reasons of record.

Claims 1, 19, 29 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. in view of applicants' statement of the prior art for the reasons of record.

Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsieh in view of applicants' statement of the prior art and Yamaguchi et al. for the reasons of record

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. in view of applicants' statement of the prior art and Yamaguchi et al. for the reasons of record.

The first sentence of applicants' "Description of the Related Art" constitutes the statement of the prior art relied on by the examiner. Use of a conventional LTHC for its concomitant function in the thermal transfer sheet of Hsieh or Suzuki et al. would have been an obvious expedient to one of ordinary skill in this art in the absence of unexpected results.

The fact that Suzuki et al. prefer a support thickness of up to 15 mm is clear evidence that thickness outside that range are also contemplated. Evidence of unexpected results for thickness greater than 15 mm has not been submitted.

The presence of particles in the prior art image formation layers inherently result in a roughened surface (i.e., some of the particles will protrude above the surface) The

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experimental modification of this prior art in order to ascertain optimum operating conditions (e.g., determine compositional proportions and layer thickness) fails to render applicants' claims patentability in the absence of unexpected results. To date, such evidence has not been submitted.

The pigments of Hsieh inherently function as matting agents.

Finally, since heat is the energy that causes substances to rise in temperature, the concept of heat resistance inherently has a "temperature condition."

2. Claims 1, 4, 17-21 and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imamura (U.S.P. 5,935,902)

Imamura teach a thermal transfer sheet comprising an image formation layer containing applicants pigments and amorphous organic polymers as well as an LTHC layer containing the same materials claimed by applicants (see column 6, lines 41-46 and 67; column 7, lines 1, 23-25 and 33-48; column 12, lines 10-52; and column 14, lines 8-10, 30, 31 and 62-65). The experimental modification of this prior art in order to ascertain optimum operating conditions (e.g., determine compositional proportions and layer thickness) fails to under applicants' claims patentable in the absence of unexpected results.

3. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imamura in view of Yamaguchi et al..

Imamura applies as per the proceeding paragraph. Yamaguchi et al. teach the result – affectivity of the heat – resistance of image formation layers on a thermal transfer sheet. Consequently, determining the optimum heat resistance of the Imamura

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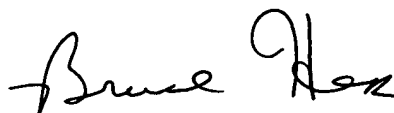
image formation layer would have been obvious to one of ordinary skill in this out in the absence of unexpected results. Such evidence has not been submitted.

4. Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Bruce Hess at telephone number (703) 308-2402.

B. Hess/lap

November 5, 2003

A handwritten signature in black ink, appearing to read "Bruce Hess", with a stylized flourish at the end.

BRUCE H. HESS  
PRIMARY EXAMINER